

Serial #: 10/056,790
Reference #: EX02-004C

REMARKS

Amendments

Specification has been amended to remove hyperlinks.

Claims have been amended to more particularly point out the claimed invention, as further described below. Support for amended claim 8 is found throughout the application, and in particular on paragraphs [0027] and [00146]. Claims 1-7 and 13-51 were canceled as they are drawn to non-elected subject matter.

The amendments to the specification or to the claims do not introduce new matter.

Objections to Specification

On paragraph 5 of the office action, the specification was objected to for containing embedded hyperlinks. Hyperlinks have been removed from the specification, and as such, the objection is overcome.

Claim Rejections – 35 USC § 112, 2nd paragraph

On paragraphs 6 and 7 of the office action, claims 8-12 were rejected under 35 USC 112, second paragraph for use of the term “RRP”, for being unclear as to the metes and bounds of the term. Applicants respectfully disagree.

MPEP 2173.05(a) provides: “The meaning of every term used in a claim should be apparent from the prior art or from the specification and drawings at the time the application is filed”. The term “RRP” has been clearly defined on paragraph [0011], as “Rhomboid Related Proteins”, and meaning a mammalian ortholog of *Drosophila Rhomboid*, and more specifically, RRP1-RRP8, and mouse RRP1 (*mRRP1*). Further detail is provided on page 6, paragraph [0023]. The examiner provides Barg S et al publication describing RRP as a “readily releasable pool”, and Savino TM et al publication describing RRP as “ribosomal RNA processing proteins”. However, given the facts provided above, and since sequences of RRP proteins that can be used in the invention are clearly identified on pages 7 and 8, paragraph [0027] of the specification, there remains little doubt as to the meaning of “RRP” in the instant specification. As such, the use of the term “RRP” meets the requirements of 35 USC 112, second paragraph. However, if the examiner still does not find this argument persuasive, and to

Serial #: 10/056,790
 Reference #: EX02-004C

further the prosecution, the examiner is authorized to recite the full name via an examiner's amendment.

Claim Rejections – 35 USC § 112, 1st paragraph

On paragraph 8 of the office action, claims 8-12 were rejected under 35 USC 112, 1st paragraph, for lack of reasonable enablement for all RRP_s. Amended claim 8 refers to RRP_s 1-8 and mouse RRP1 (mRRP1), and as such, overcomes the rejection.

On the same paragraph, the examiner kindly indicates the specification as enabling for an RRP1, 2, 4, 5, 6, 7, 8, and mRRP1. However, the examiner does not include RRP3 in his indication. This might be due to a misreading of the specification. The specification teaches the characterization of 9 different RRP polypeptides by sequence identification numbers. Specifically, paragraph [0027] provides RRP1 through 8 and mouse mRRP1 polypeptides, having SEQ ID NOs: 2, 4, 6, 8, 10, 12, 14, 16, and 46, respectively. Thus, the specification is enabling for RRP 1 through 8, and mRRP1. Currently amended claim 8 reflects these polypeptides.

As such, claims 8-12 meet the requirements of 35 USC 112, 1st paragraph.

CONCLUSION

It is believed that all the objections and rejections raised by the Examiner have been addressed and that the application is in condition for allowance. The Examiner is encouraged to telephone the undersigned with any questions or comments regarding this response.

RECEIVED
 CENTRAL FAX CENTER

Respectfully submitted,

OCT 27 2003


 Laleh Shayesteh Reg. No. 47,937

Dated: October 27, 2003

EXELIXIS, INC.
 170 Harbor Way, P.O. Box 511
 South San Francisco, California 94083-0511
 Telephone: (650) 837-8180
 Facsimile: (650) 837-8234

OFFICIAL